



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

elf

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/107,110	06/30/98	BERRY	J 777.161US1

LM02/1003
SCHWEGMAN LUNDBERG WOESSNER & KLUTH
PO BOX 2938
MINNEAPOLIS MN 55402

EXAMINER

HUYNH, B

ART UNIT	PAPER NUMBER
----------	--------------

2773

12

DATE MAILED:

10/03/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/107,110

Applicant(s)

Berry et al

Examiner

Huynh-Ba

Group Art Unit

2773



☒ Responsive to communication(s) filed on Aug 22, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

- ☒ Claim(s) 1-21, 25, and 27 is/are pending in the application.
- Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-21, 25, and 27 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claims _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of References Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

BA HUYNH
PRIMARY EXAMINER

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2773

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Earlier presented claims 22-24 and 26 were restricted and were canceled by the applicants as indicated in paper #9. Therefore the number next following the highest numbered claims previously presented is 27.

Accordingly, misnumbered claim 26 has been renumbered as 27.

Claim Rejections - 35 USC § 103

2. Claims 6-13, 16-18, 21 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Mastering Microsoft Office 97 (Office 97). Rationales for the rejection continue to be as set forth in the past Office action.

3. Amended claims 1-5, 14-15, 19-20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Mastering Microsoft Office 97 (Office 97). Rationales for the rejection set forth in the last Office action are incorporated into the following remarks.

Art Unit: 2773

- As for amended claims 1, 13-15: The My-Document is installed under Office 97 and is applications independent. Since the My-Document is application independent file operation dialog box under My-Document is also applications independent.

- As for amendment claim 19: The Document menu option links to the My-Document folder which contains 15 most recently used files and/or folders (Figs 6.2 and 10.3; page 238: see "NOTE").

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claim 2~~7~~ is rejected under 35 U.S.C. 102(a) as being anticipated by the Microsoft Office 97.

- As for claim 2~~3~~: In a computer system having an operating system, Microsoft Office 97 discloses a method comprising providing default document folder call My-Document. My Document folder is for use by two or more application and is defined within the operating system (page 6), independent from the applications. A My-Document icon is displayed during file operation related to the applications (page 238).

Art Unit: 2773

Response to Arguments

6. Applicant's arguments filed 8/22/00 have been fully considered but they are not persuasive.

As for claim 1: In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, displaying the My-Document icon on a primary screen would provide easy access to the icon. In response to applicant's argument that there is no need to display the My Document icon on the primary screen since the My-Computer icon already there, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

As for claims 6, 15,16: The My-Document default folder is application independent, and is defined within the computer operating system.

As for claim 13,14: My-Document is a default folder for all Word, Excel, Powerpoint, Outlook, and also capable for Access, the folder is installed with Office 97.

Art Unit: 2773

As for claims 17,18: The My-Document is installed under Office 97 and is applications independent. Since the My-Document is application independent file operation dialog box under My-Document is also applications independent.

As for claims 12,25: A Save As dialog box is provided for re-directing the file to a specified folder or file type. The Save As dialog will not be displayed if a file have already named and saved (page 239), which implies that the determining steps are implicitly included when the file is saved.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Art Unit: 2773

Inquires

Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 308-9051 may be used for formal communications or (703) 308-6606 for informal or draft communications. NOTE: A Request for Continuation (Rule 60 or 62) cannot be faxed.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huynh-Ba whose telephone number is (703) 305-9794. The examiner can normally be reached on Monday-Friday from 8.00AM to 4.30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Kim, can be reached on (703) 305-3821.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Huynh-Ba
Primary Examiner
Art Unit 2773
2/12/99

BA HUYNH
PRIMARY EXAMINER